

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-3 and 5-30 are now present in this application. Claims 1 and 18 are independent. By this Amendment, the specification has been amended, claim 4 has been canceled, and claims 1, 5-7, 11, 14, 18 and 27 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 7 and 14 are rejected under 35 USC §112, second paragraph for being indefinite in that, in claim 7, the term "smaller" is not used properly and, in claim 14, it is not clear how a flange can extend from a concave surface. This rejection is respectfully traversed.

In an attempt to overcome this rejection, Applicants have amended claim 7 to recite that the smaller dimension is a diameter. Applicants have also amended claim 14 to recite that the flange extends from the floating body, which they respectfully submit has a clear and definite meaning.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Amendments to the Specification

The specification has been amended to correct obvious minor typographical errors. No new matter is involved.

Rejection Under 35 U.S.C. § 102

Claims 1-3 and 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 2,985,966 to Martin. This rejection is respectfully traversed.

Applicants respectfully submit that Martin does not anticipate claim 1, as amended to include subject matter recited in originally filed claim 4, and other subject matter, because Martin does not disclose the claimed combination of features which include a valve installed in the tub opening to float in an untethered manner on the foam. Support for this amendment is found throughout Applicants' original disclosure, which clearly shows a check valve that is not tethered to anything.

Dependent claims 2, 3 and 6 also contain this amended feature.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3 and 6 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 4, 5, 7-9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent 5,797,426 to Powell. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is

not being repeated here.

This rejection is moot with respect to claim 4, which has been canceled.

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981,

180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicants respectfully submit that neither Martin nor Powell discloses or suggests the positively recited combination of features recited in claims 4, 5, 7-9 and 11 and that the office Action fails to provide objective factual evidence of proper motivation to modify Martin in view of

Powell, as suggested.

Claim 1, as amended, recites a combination of features including the subject matter recited in originally filed claim 4, which has been canceled, which recites a valve installed in the opening to float on the foam, and adds an untethered valve feature.

Martin, the base reference applied in this rejection, discloses a flapper check valve 175 located within cup 174 into which water is dispensed by conduit 173, which is located separate and apart from, and above cup 174. In normal operation, when water is dispensed into the cup 174, flap 174 appears to move away from the outer wall of cup 174 to permit water dispensed into cup 174 to enter into the tub 24. Flapper check valve 175 is disclosed as preventing suds and steamy vapors from escaping during washing. This appears to be accomplished by movement of flapper check valve 174 to rest against the outer wall of cup 174. In that position, Applicants respectfully submit that flapper check valve does not float on the suds or vapors. Rather, it appears that the flap element of flapper check valve 175 is not free to float in an untethered manner, as recited, because it is always tethered to the tub at one part of the flap.

In an attempt to provide a float valve in Martin, the Office Action turns to Powell, which discloses a one-way check valve and fluid trap for condensate moisture drain systems. Powell discloses a combination of features including an inflow conduit 31, a fluid trap assembly 32, an outflow conduit 33, a float 1, a housing 11 and a seal 22 that is “easily connectable to the outflow opening of condensate moisture drain systems, to be used either as a primary fluid trap or a secondary fluid trap for systems having a fluid trap.”

The Office Action states that it would be obvious to include a float valve of the type that

Powell discloses in fluid connection with the water inlet of a washing machine because they are well known substitutes that provide unidirectional flow.

Applicants respectfully disagree with this conclusion for a number of reasons.

Firstly, the Office Action fails to explain how Powell's combination check valve and trap assembly will fit into Martin's washer/dryer as a replacement for Martin's cup 174 and flapper check valve, especially when Martin shows no need for an additional trap assembly and will probably have to be redesigned and re-sized to accommodate the additional trap assembly because of the extra space it will take up in the washer dryer.

Secondly, the Office Action fails to explain exactly how Powell's check valve and trap assembly will be a workable substitute in Martin's system without substantial modification. For example, if the water supply conduit 173 in Martin feeds water into Martin's tub 24 by directing it into inflow conduit 31 of Powell's check valve and trap assembly, how will Martin's suds be kept from spilling out through vent holes 16 in sleeve 13, and how will the suds be channeled to the float 1 without substantial redesign of Martin's tub? In this regard, Applicants respectfully submit that the significantly different structural features of Martin and Powell teach away from making the proposed reference combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Appellant.

The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Appellant. See W.L. Gore &

Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), cert. denied, 469 U.S. 851 (1984); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); In re Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (CCPA 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the Appellant). See, In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994).

In this case, Applicants respectfully submit that Powell will have to be substantially and inventively redesigned to even possibly work as proposed and, as a result, these references teach away from their proposed combination.

Further, with respect to claim 7, Martin's check valve does not have a diameter such that it fits within an opening in the tub, and Powell does not disclose that its check valve and trap assembly is designed to fit in the opening in a washer tub, so there is absolutely no objective factual evidence presented in this rejection of proper motivation to modify Martin to provide a float valve assembly having a valve that is smaller than the opening in the tub. In fact, Martin's flap check valve 175 is substantially larger than the opening in the tub that it closes.

Thus, the Office Action fails to make out a *prima facie* case of proper motivation to make the proposed modification of Martin in view of Powell and fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent 4,821,537 to Zinkann et al. ("Zinkann"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Martin does not render obvious the invention of claim 1, from which claim 10 depends, for reasons discussed above so, even if it were obvious to modify Martin, as suggested, the resulting modified version of Martin would not render the claimed invention obvious.

Applicants also respectfully submit that the office Action does not provide objective factual evidence of proper motivation to modify Martin in view of Zinkann, as suggested. In this regard, the rejection notes that Zinkann discloses a corrugated pipe between its detergent dispenser and tub and a float valve between the bellows pipe and the tub and concludes that it would be obvious to include a bellows pipe. Presumably, the rejection means that it would be obvious to include a bellows pipe in Martin. Applicants respectfully disagree. Martin's check valve is located at its water inlet, whereas Zinkann's check valve is located at the water outlet drain, where Zinkann's corrugated drain pipe is located. The Office Action does not provide objective factual evidence that one of ordinary skill in the art would be motivated to use Zinkann's corrugated drain pipe as a substitute for Martin's water inlet conduit 173, and Applicants respectfully submit that it would not be obvious to do so.

Thus, the Office Action fails to make out a *prima facie* case of proper motivation to make the proposed modification of Martin in view of Zinkann and fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 12 stands rejected under 35 USC §103(a) as being unpatentable over Martin in view of Powell and further in view of U.S. Patent 3,691,797 to Smith. This rejection is respectfully traversed.

Applicants respectfully submit that the Martin-Powell reference combination does not render obvious the subject matter of claims 1 and 5, from which claim 12 depends, for reasons discussed above. Accordingly, even if one of ordinary skill in the art were properly motivated to modify Martin-Powell in view of Smith, as suggested, the resulting modification would not render the claimed invention obvious.

The Office Action admits that neither Martin nor Powell discloses a shaft on their float or check valve. In an attempt to remedy this admitted deficiency, the Office Action turns to Smith. Unfortunately, Smith does not disclose a check valve with a shaft, either. In this regard, Applicants respectfully submit that Smith's spherical valve member 80 is disclosed as just a sphere with no shaft extending therefrom. As shown in Fig. 2, spherical valve member 80 is resting on ribs 81, which extend inwardly from check valve assembly housing 55, and no shaft is shown extending from spherical valve member 80. Applicants respectfully submit that the u-shaped element shown extending below spherical valve member 80 in Fig. 2 is merely an end view of a rib 81 on which spherical valve member 80 rests – see the paragraph bridging cols. 4 and 5 for a description of ribs 81 and spherical valve member 80. Applicants can find no explicit disclosure in Smith of a shaft extending from spherical valve member 80 and the Office Action has not provide objective factual

evidence of an inherent disclosure of such a shaft, keeping in mind that for something to be inherently disclosed, it must necessarily be disclosed, i.e., not just possibly disclosed and not just probably disclosed. What is inherent, must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Provisional Double Patenting Rejection

Claims 1, 2, 4-6, 10-17 and 27-30 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application Serial No. 10/746,155. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants are herewith submitting a Terminal Disclaimer disclaiming the terminal portion of any patent granted on the present application which would extend beyond the expiration of any patent which issues from U.S. Application No.

10/746,155. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Allowable Subject Matter

The Examiner states that claims 18-26 would be allowable if rewritten in independent form.

Applicant thanks the Examiner for the early indication of allowable subject matter in this application. Objected-to claim 18 has been rewritten into independent form, and should therefore be allowed. Also, claims 19-26 depend, either directly or indirectly, from independent claim 18, and are therefore allowable based on their dependence from claim 18 which is believed to be allowable.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

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Art Unit 1746

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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.


Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: February 28, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

James T. Eller, Jr.

Reg. No.: 39,538

P.O. Box 747

Falls Church, Virginia 22040-0747

Telephone: (703)205-8000

JTE/RJW/jmb/jg

Attachment: Terminal Disclaimer 